

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Summit Entertainment, LLC

Serial No: 77/921,988

Filed: January 28, 2010

Class: 18

Mark: ECLIPSE


Examiner:

Priscilla Milton

Law Office: 110

APPLICANT'S REPLY BRIEF

Applicant Summit Entertainment, LLC ("Applicant") hereby submits this reply brief in support of its appeal of the Examiner's refusal to register Applicant's trademark ECLIPSE under § 2(d) of the Trademark Act on the ground that it is likely to cause confusion, to cause mistake, or to deceive with the following marks ("Cited Marks"):

- U.S. Registration No. 3,018,770 for ECLIPZE for "anti-uv umbrellas used for sun protection, namely, stick, 2-fold and 3 fold models" in Class 18 owned by Solar Solutions LLC ("Solar Solutions");
- U.S. Registration No. 4,080,586 for  for "trunks and travelling bags, namely, tote bags," in Class 18 owned by Ellison Educational Equipment, Inc. dba Sizzix ("Sizzix").



10-30-2015

A. Applicant's Mark ECLIPSE is Different from Either ECLIPZE or ECLIPS Shown in Registrants' Marks

The Examiner's contention that the phonetic similarity between Applicant's mark and the Cited Marks "may be sufficient to support a finding that the marks are confusingly similar" is inapplicable in the instant case. (Opposition, p. 5.)

"Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a determination that confusion is likely even if the goods are identical or closely related; rather, taking into account all of the relevant facts of a particular case, similarity as to one factor alone may be sufficient to support a holding that the marks are confusingly similar." TMEP 1207.01(b)(i). See *In re Thor Tech, Inc.*, 90 USPQ.2d 1634, 1635 (TTAB 2009); *In re White Swan Ltd.*, 8 USPQ.2d 1534, 1535 (TTAB 1988).

Even if Applicant's mark ECLIPSE is found to be phonetically similar to the Cited Marks ECLIPZE or ECLIPS & Design (which it is not), other differences between Applicant's mark and the Cited Marks render the respective marks dissimilar.

Applicant's mark ECLIPSE is not spelled the same as the Cited Mark ECLIPZE. Even the Examiner agrees that Solar Solutions' mark ECLIPZE is a "novel spelling" of the word ECLIPSE. (Opposition, pg. 5.) This visual difference in spelling, even by one letter, is significant enough to distinguish Solar Solutions' ECLIPZE mark from Applicant's mark. See, e.g., *Echo Drain v. Newsted*, 307 F. Supp.2d 1116, 1126 (C.D. Cal. 2003) (no likelihood of confusion between ECHO DRAIN and ECHOBRAIN); *Colgate-Palmolive v. J.M.D. All-Star Import*, 486 F. Supp.2d 286, 290-91 (S.D.N.Y. 2007) (no likelihood of confusion between COLGATE and COLDDATE).

The Examiner has also failed to give sufficient weight to the visual differences between Applicant's mark ECLIPSE and Sizzix's mark ECLIPS & Design. The Federal Circuit has held

that marks that share a common element may not be likely to cause confusion, where one of the respective marks incorporates additional elements that serve to distinguish the marks. *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990). In *Electrolyte*, the Board had previously held that the marks K+ & Design and K+ EFF, both used for a dietary potassium supplement, were likely to cause confusion. The Federal Circuit reversed the Board's ruling, holding that "the TTAB erred in its dominant focus on the K+ in both marks, to the substantial exclusion of the other elements of both marks." *Id.* at 647. The Court went on to hold that there was no likelihood of confusion between the marks, based on the differing commercial impressions resulting from the extra elements contained in the marks. *Id.*

Electrolyte is analogous to the case at hand in that it shows that the mere comparison of one element of a mark is insufficient to support a likelihood of confusion. Just as was the case with *Electrolyte*, the difference in Applicant's mark as compared to the Cited Mark ECLIPS & Design creates varying commercial impressions. There is no evidence of record that the relevant consumers would understand Sizzix's spelling of ECLIPS to be a novel spelling of ECLIPSE. Instead, consumers are likely to view the mark as "e-clips", especially given the separation of the letter "e" and the wording "clips" and the focus on the letter "e" in the Cited Mark. Furthermore, the term "Eclipse" stands for a lunar solar event. Sizzix's use of a heart design and wings holds no association with a lunar solar event. The Board should therefore find that these marks are not confusingly similar, just as the Federal Circuit did in *Electrolyte*.

**B. Applicant's Limitation of Goods to "Motion Pictures and Entertainment"
Sufficiently Distinguishes its Goods from Registrants' Goods**

The Examiner's evidence of record does not establish that Applicant's goods, as limited to goods "relating to motion pictures and entertainment," are similar or related to Registrants' goods.

First, the Examiner has not cited to any cases where bags, key chains, leashes, umbrellas, or any other goods in Class 18 relating to “motion pictures and entertainment” have been determined to be similar or related to anti-uv umbrellas or tote bags. Furthermore, the Examiner has not cited to any cases addressing the relatedness to goods concerning “motion pictures and entertainment” to *any unrestricted identification of goods* in Class 18.

Second, the Examiner has not made of record any web pages or other evidence purportedly reflecting use in commerce where bags, key chains, leashes, umbrellas or any other goods in Class 18 relating to “motion pictures and entertainment” are offered under the same brand as umbrellas or tote bags.

Third, the Examiner has not made of record any third party registrations in which bags, key chains, leashes, umbrellas, or other goods in Class 18 relating to “motion pictures and entertainment” are included in the same registration as umbrellas and tote bags in general. Furthermore, the Examiner has not identified any registrations in which *any goods* relating to “motion pictures and entertainment” are included in the same registration as umbrellas and tote bags.

The Board has recently held that “associated with” language in the identification of goods or services may be “precatory language, and not binding on consumers” when encountering a particular mark if the language does not alter the nature of the goods or represent that the goods will be marketed in any particular limited way, or through limited trade channels or to any particular class of consumers. *See In re i.am.symbolic, llc*, 2015 TTAB LEXIS 369 at *10 (Oct. 7, 2015). Applicant respectfully submits that the present limitation, “relating to motion pictures and entertainment concerning motion pictures” contains a meaningful limitation that would be reflected in the relevant marketplace. Applicant’s restriction of its bags, umbrellas and other

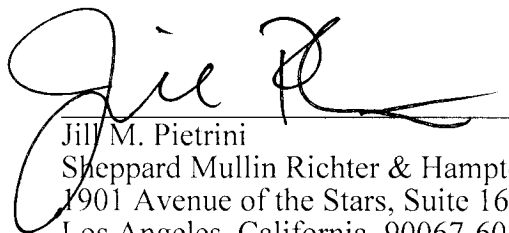
goods in Class 18 to those “relating to motion pictures and entertainment concerning motion pictures” means that Applicant’s goods are limited to ones directed to motion pictures and entertainment. Similarly, Applicant would be precluded from renewing its registration of INSURGENT for bags, umbrellas and other goods in Class 18 that do not relate to motion pictures and entertainment. Applicant’s marketing of its bags, umbrellas and other goods in Class 18 must have a connection to motion pictures and entertainment in order to assert valid trademark registration rights in its mark. In other words, Applicant is bound by the language in its identification of goods to advertise and sell goods that do in fact relate to motion pictures and entertainment concerning motion pictures. This in turn means that the relevant consumers will only encounter goods from Applicant that are *Twilight* Motion Picture branded merchandise. Further, Registrant’s marks cannot be associated with the *Twilight* Motion Pictures, lest the Registrants willfully or negligently intend to violate Applicant’s rights.

This limitation is the identification of goods weighs in favor of a finding that there is no likelihood of confusion between Applicant’s mark and the Cited Mark.

C. **CONCLUSION**

For the reasons stated above, in its opening brief, and in all of Applicant’s other documents and evidence, Applicant respectfully requests that the Board reverse the decision of the Examiner and allow the mark to proceed to publication. Applicant requests oral argument and has separately filed a Request for Oral Argument.

Respectfully submitted,

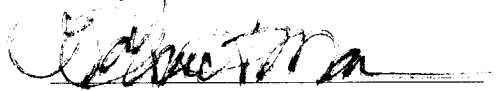


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Dated: October 27, 2015

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on this 27th day of October, 2015.


LaTrina A. Martin

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